

REMARKS / ARGUMENTS

Status of Claims

Claims 1-10, 12-19 and 35 were pending. Claims 1-10, 12-19 and 35 stand rejected. Applicant has amended claim 9. Claims 1-8 and 35 have been cancelled without prejudice or disclaimer. Accordingly, claims 9-10 and 12-19 are presented and at issue. Applicant respectfully submits that the rejections under 35 U.S.C. §103(a), have been traversed, that no new matter has been entered, and that the application is in condition for allowance.

Rejections Under 35 U.S.C. §103(a)

Claims 1-19, and 35 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Knockeart et al (US 6,622,083).

Applicants traverse these rejections for the following reasons.

Applicants respectfully submit that the obviousness rejection based on Knockeart is improper as Knockeart fails to teach or suggest each and every element of the instant invention in such a manner as to perform as the claimed invention performs. For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a *prima facie* case of obviousness. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The Examiner must meet the burden of establishing that all elements of the invention are taught or suggested in the prior art. MPEP §2143.03.

Independent claim 9 has been amended to recite, *inter alia*, “instructing the vehicle navigation system to use the agenda to determine a route to follow to the destination based upon the requested time of arrival, and also based upon at least one of: (a) a cellphone coverage preference, (b) a road condition preference, or (c) a scenic route preference”. Claim 9 has also been amended to recite, *inter alia*, “using the portable agenda replication device to update the agenda in the middle of a multiple-stop trip wherein, when a location is dropped from the agenda or a new entry is added to the agenda, the route is automatically recalculated by the vehicle navigation system in

response to the vehicle navigation system receiving the updated agenda from the portable agenda replication device.”

Support for these claimed features is found throughout Applicants’ specification, for example in FIGs. 3-6 and paragraphs [0013], [0021], [0057] – [0062] and [0066]-[0070]. No new matter has been added. Moreover, the amended claims still read on the elected species (species 1), directed to transferring information from a remote computer to a vehicle navigation system.

Knockeart discloses techniques for using a removable device, such as a PDA, in conjunction with a driver information system. The removable device is brought to a vehicle and data in the removable device is transferred to the vehicle. However, Knockeart fails to teach or suggest Applicant’s claimed method of “using the portable agenda replication device to update the agenda in the middle of a multiple-stop trip wherein, when a location is dropped from the agenda or a new entry is added to the agenda, the route is automatically recalculated by the vehicle navigation system in response to the vehicle navigation system receiving the updated agenda from the portable agenda replication device.” Knockeart neither discloses nor suggests the ability to change or update an agenda item while a trip is in progress.

By way of further distinction, Knockeart fails to teach or suggest a portable agenda replication device instructing a vehicle navigation system to use an agenda to determine a route to follow to the destination based upon a requested time of arrival and at least one of (a) a cellphone coverage preference, (b) a road condition preference, or (c) a scenic route preference” as set forth in Applicant’s claim 9.

In view of the foregoing considerations, it is submitted that claim 9 is patentable over Knockeart. Dependent claims inherit all of the limitations of the respective parent claim and any intervening claim. Claims 10 and 12-19 inherit all of the limitations of claim 9. Accordingly, it is submitted that claims 12-19 are patentable over Knockeart for the reasons set forth above in connection with claim 9.

In view of the foregoing, Applicants submit that Knockeart fails to teach or suggest each and every element of the claimed invention and is therefore wholly

inadequate in its teaching of the claimed invention as a whole. Knockeart fails to motivate one skilled in the art to do what the patent Applicants have done and includes no suggestion whatsoever that it would be desirable for its portable device to provide instructions to the vehicle. Additionally, Knockeart fails to recognize a problem recognized and solved only by the present invention, fail to offer any reasonable expectation of success to perform as the claimed invention performs, fail to teach a modification to prior art that does not render the prior art being modified unsatisfactory for its intended purpose, and discloses a substantially different invention from the claimed invention, and therefore cannot properly be used to establish a *prima facie* case of obviousness. Accordingly, Applicant respectfully requests reconsideration and withdrawal of all rejections under 35 U.S.C. §103(a), which Applicant considers to be traversed.

In light of the forgoing, Applicant respectfully submits that the Examiner's rejections under 35 U.S.C. §103(a), have been traversed, and respectfully requests that the Examiner reconsider and withdraw these rejections.

If a communication with Applicant's Attorneys would assist in advancing this case to allowance, the Examiner is cordially invited to contact the undersigned so that any such issues may be promptly resolved.

The Commissioner is hereby authorized to charge any additional fees that may be required for this amendment, or credit any overpayment, to Deposit Account No. 06-1130. In the event that an extension of time is required, or may be required in addition to that requested in a petition for extension of time, the Commissioner is requested to grant a petition for that extension of time that is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to the above-identified Deposit Account.

Respectfully submitted,

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